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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,319	01/11/2002	Fumio Sugaya	Q66579	4442

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EXAMINER	
GORDON, BRIAN R	

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,319	SUGAYA ET AL.	
	Examiner	Art Unit	
	Brian R. Gordon	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 6-9-06.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,2,5 and 6 is/are pending in the application.

4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-2 and 5-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 9, 2006 have been fully considered but they are not persuasive.

In response to applicant's remarks of the 112 second, paragraph rejection, the examiner asserts there has been other decisions handed down since the 1976 case of *In re Noll.*

The M.P.E.P. states:

Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and nambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). Where means plus function language is used to define the characteristics of a machine or manufacture invention, claim limitations must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof." (Two en banc decisions of the Federal Circuit have made clear that the Office is to interpret means plus function language according to 35 U.S.C. 112, sixth paragraph. In the first, In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)

Applicant further cites *Atmel Corp v. Information Storage Device, Inc.* and *In re Dossel* to support applicant's position. The circumstances or factors considered in these cases are not equivalent to that of the instant applicant, hence the cases do not

adequately support applicant's position. Both cases are directed to software and hardware computer components.

Applicant provides passage directed to the correction means 43, however the passage fails to specify any examples of the correction means structure. Applicant further asserts such means is an "electrical circuit". The examiner asserts the specification does not specify the means as being such circuit. Furthermore a simple electrical circuit will not function as such. Such a means would require some type of logical, analytical, computing means in such circuit to perform the function as claimed.

For such reasons, the examiner hereby maintains the previous 112, second paragraph, rejection.

As stated by applicant if the prior art does not disclose the specific function of the means, the examiner as required to show how the structure of the prior art is equivalent. Applicant asserts the correction means is an "electrical circuit". In view of such, Marguiss et al disclose a number of electrical circuits plus a number of control units, processors, controllers, and states the device is computer controlled or automatically controlled. All of the elements are structurally equivalent or include "electrical circuits" which allow for such logical computing required to perform the claimed function. As such the previous 103 rejection of the claims is hereby maintained.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "correction means which compensates for fluctuation in the value of the optical density". Applicants have invoked 112, 6th paragraph, which requires that a corresponding structure be described in the specification and equivalents there. A review of the specification finds no structure which Applicants have correlated to the claimed mean-plus-function, as required. Thus, the claims are indefinite.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 5,037,613 to Shaw et al in view of US patent 6,838,051 to Marquiss et al.

Shaw et al disclose incubators comprising with a plurality of element chambers (66) which are arranged along the outer periphery of the incubator rotor (64) and each of which accommodates a dry analysis element (E) spotted with a sample and incubates the dry analysis element and a light measuring means (90) having a light measuring head (92) which measures the optical density of the dry analysis element are known.

With respect to Applicants' claimed improvement, applicants recite the light measuring means having a correction means that compensates for fluctuations in the optical density.

Marquiss et al teach a sample processing system comprising a light monitor (5122). Marquiss et al teach that the light monitor used to correct for fluctuations in the intensity of light provided by the light sources. Such corrections may be performed by reporting detected intensities as a ratio over corresponding times of the luminescence intensity measured by the detector to the excitation light intensity measured by the light monitor. The light monitor also can be programmed to alert the user if the light source fails. Thus, the light monitor is in communication with the light source, as recited in claim 6. See col. 44, lines 40-48. The light monitor of Marquiss et al is equivalent to the claimed "correction means which compensates for fluctuation in the value of the optical density" since Marquiss et al teach that the light monitor corrects for fluctuations in the intensity of light.

It would have been obvious to one of ordinary skill in the art to modify the incubators known in the art with a light monitor to provide a manner for assuring accurate results by correcting for fluctuations in light intensity.

With respect to claim 2, the manner in which the correction means operates within the device is not sufficiently limiting to make the claims patentable since the limitation is directed to the manner in which the device operates. See MPEP 2114.

With respect to claims 5, Marquiss et al teach a transport module (2100) as a part of the system for transporting slides from 1/0 areas to various other functions in the system. As a part of the transport module, the reference teaches a bar code reader (col. 17) which may serve as a position detector to determine the position of the test slide, as claimed by applicants.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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